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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,091	11/19/2001	James A. Fitch	42365-00790	9344

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TOWNSEND AND TOWNSEND AND CREW/22395
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

FOX, BRYAN J

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/989,091	Applicant(s) FITCH ET AL.	
	Examiner Bryan J Fox	Art Unit 2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/30/2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 10-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

The terminal disclaimer filed on August 30, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent Number 6, 321, 092 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Election/Restrictions

Newly submitted claims 10-20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the original claim was directed towards location finding via at least two different methods, however, the new claims are directed toward the specific interface of the location finding system and the format of the input and output to the system.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 10-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Kauser et al (US005724660).

Regarding claim 1, Kauser et al discloses a mobile location module (MLM) to determine the specific location of a mobile telephone (see column 5, lines 23-32) that uses the signal strengths of base stations received at the mobile (see column 6, lines 1-12) as well as GPS (see column 9, lines 19-29) for the location determination, which reads on the claimed, "method for use in a wireless network to obtain requested location information regarding a wireless station and provide the requested location information to a wireless location application, the wireless network being associated with at least a first location source and a second location source for providing information regarding locations of wireless stations in the network." The MLM receives the signal strength information (see column 6, lines 1-23) as well as the GPS information (see column 9, lines 19-29), which reads on the claimed, "providing a system for receiving location information from the first and second location sources, where the first and second location sources employ first and second location finding technologies for locating wireless stations," and, "storing data in memory accessible by said system relating to said first location input and said second location input," and, "second receiving, at said system, a first location input based on first location information provided by said first location source, and a second location input based on second location information provided by said second location source." The MSC can initiate a location function

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based on various criteria in the MLM (see column 5, lines 33-67), which reads on the claimed, "establishing an interface for communications between said system and said wireless location application, where said interface defines a standard for requesting and providing said requested location information," and, "first receiving, at said system via said interface, a location request regarding said wireless station from said wireless location application, said location request requesting said requested location information in accordance with said standard of said interface." The MLM uses the information from the signal strengths and GPS to determine the location (see column 11, line 43 – column 12, line 21 and figure 10), which reads on the claimed, "obtaining said request location information by selectively retrieving data from said memory based on said location request." The MLM the routes this information to the appropriate end user (see column 12, lines 22-35), which reads on the claimed, "outputting said requested location information to said wireless location application in accordance with said standard of said interface, wherein said wireless location application is selectively supported by said first location source and said second location source via said interface."

Regarding claim 2, Kauser et al discloses using both the signal strength information and the GPS information to determine a location (see column 11, line 43 – column 12, line 21), which reads on the claimed, "obtaining requested location information comprises retrieving said first location input from said first location source and retrieving said second location input from said second location source; and combining said first and second location inputs to generate said request location information."

Regarding claim 3, Kauser et al discloses an error component associated with the estimate of the mobile telephone using the signal strengths (see column 7, lines 48-65), an error component associated with the GPS measurements (see column 9, line 53 – column 10, line 65) and an error associated with the combination of methods (see column 11, line 43 – column 12, line 21), which reads on the claimed, “said first and second location inputs and said requested location information are associated with first, second and third uncertainties, respectively.”

Regarding claim 4, Kauser et al discloses using the GPS measurements with the signal strength measurements in order to give a more accurate location area estimate (see column 3, lines 10-15), which reads on the claimed, “said third uncertainty is reduced relative to each of said first and second uncertainties.”

Regarding claim 5, Kauser et al discloses that if the mobile telephone dials a certain number, the MSC can initiate the location function (see column 5, lines 40-47), which reads on the claimed, “invoking at least one of the first and second location sources via a wireless network interface to provide at least one of said first and second inputs regarding said wireless station.”

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kauser et al in view of Eizenhoefer (US005809424A).

Regarding claim 6, Kauser et al fails to expressly disclose that receiving the location request further comprises receiving at least one specification regarding a quality of said requested location information.

In a similar field of endeavor, Eizenhoefer discloses that a location request includes an information element indicating the level of accuracy of location finding requested (see column 12, lines 21-37).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kauser et al with Eizenhoefer to include the above indication of desired accuracy of a location in order to save system resources when the most accurate location is not needed.

Regarding claim 7, Kauser et al fails to disclose that obtaining said requested location information comprises obtaining location information conforming to the specification.

In a similar field of endeavor, Eizenhoefer discloses choosing the method of location finding, e.g., call area finding or single location finding, etc. determined by the accuracy level requested in the location request (see column 12, lines 21-37).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kauser et al with Eizenhoefer to include the above indication of desired accuracy of a location in order to save system resources when the most accurate location is not needed.

Regarding claim 8, Kauser et al fails to expressly disclose that the specification defines an allowable accuracy of the location information.

In a similar field of endeavor, Eizenhoefer discloses that a location request includes an information element indicating the level of accuracy of location finding requested (see column 12, lines 21-37).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kauser et al with Eizenhoefer to include the above indication of desired accuracy of a location in order to save system resources when the most accurate location is not needed.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kauser et al in view of Eizenhoefer as applied to claim 6 above, and further in view of Singer et al (US005485163A).

Regarding claim 9, the combination of Kauser et al and Eizenhoefer fails to expressly disclose the specification defines an allowable parameter of the location information.

In a similar field of endeavor, Singer et al discloses that a request may include a request for tracking (see column 4, lines 33-47).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Kauser et al and Eizenhoefer to include the above ability to request tracking in order to provide the distance and direction of the mobile as well as the location as suggested by Singer et al (see column 4, lines 33-47).

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J Fox whose telephone number is (571) 272-7908. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bryan Fox
April 11, 2005


CHARLES APPIAH
PRIMARY EXAMINER